

REMARKS

Summary of Specification Amendment

A new Abstract in compliance with M.P.E.P. §608.01(b) is submitted. No new matter is added.

Summary of Claim Amendments

Claims 1-6 and 9-25 are amended to address the minor informalities/objections and rejections under 35 U.S.C. §112, second paragraph, of the Office Action.

Claim 1 has been amended to include the recitations of claims 7 and 8 and recitations suggested by the Examiner.

Claim 23 has been amended to include the recitations of claim 7.

Accordingly, claims 7-8 are cancelled and no new matter is added.

Summary of the Official Action

The Office Action states that the executed declaration is deficient because the priority date has been transposed.

The Office Action states that a new declaration in compliance with 37 C.F.R. §1.67(a) may be needed.

Claims 2, 3, 12-13, 19, and 24-25 are objected to.

The Office Action states first that the recitations of “organic salts” in claims 2, 12, and 24 should be amended to “organic acids.” The Office Action also states that claims 2-3, 12-13, 19, and 24-25 contain improper Markush group and /or alternative language.

Claims 1-22 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action lists numerous places that claims are not in compliance with 35 U.S.C. §112, second paragraph. Appropriate corrections are requested.

Claims 1-6, 8-10, and 23-25 are rejected under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent No. 3,551,204 ("BOLGER").

The Office Action states that BOLGER discloses a solvent composition capable of selectively dissolving various epoxy resin systems while leaving metallic and most other polymer systems undamaged. The composition contains alkali metal hydroxide and an organic solvent. The Office Action states that Examples 1-4 of BOLGER contain all of the recitations of the rejected claims.

Claims 11-16 and 18-22 are also rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over BOLGER.

The Office Action notes that although BOLGER does not provide any working examples that teach "separating the inorganic matter from the liquid obtained in step (1)," BOLGER discloses the step of "removing residual solvent composition from said devices or wiring.' (Col 5). Alternatively, the Office Action states that even if those claims are not anticipated, methods falling within the scope of claims 11-16 and 18-22 would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, because the

broad teaching of BOLGER clearly encompass methods meeting all material limitations of the rejected claims.

Claims 7 and 17 are rejected under 35 U.S.C. §103(a) as being obvious over BOLGER in view of any of Japanese Unexamined Patent Application Publication Nos: 8-325436, 8-325437, 8-325438, 9-316445, or 10-126052.

The Office Action states that although BOLGER does not appear to teach or suggest that the epoxy resin-cured product contains a halogen atom, the cited Japanese documents all disclose an epoxy resin-cured product having a halogen atom. The Office Action concludes that it would have been obvious to modify BOLGER to select an epoxy resin-cured product containing a halogen atom because such use in the processing of printed wiring boards was known in the art.

Claims 23-25 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,536,439 ("HARBIN").

The Office Action states that various examples of HARBIN disclose a cleaning composition containing potassium hydroxide and an organic solvent and thus HARBIN anticipates claims 23-25 because the difference in the preamble of the claims does not patentably distinguish the claims over HARBIN.

Claims 23-25 are also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,780,894 ("SHIBATA").

The Office Action states that although the conflicting claims are not identical, they are not considered patentably distinct from each other. The

Office Action further states that the difference in preamble language does not patentably distinguish the instant composition claims.

Response

Oath/Declaration

In response to the statement that the executed declaration of May 31, 2002 is deficient, a newly executed declaration has been prepared which reflects the correct date of foreign priority application and is being concurrently filed with this Amendment.

However, one of the inventors, Ayako MATSUO, has changed her name due to marriage. Therefore, Applicants will file a Petition to change inventor's name shortly after collecting necessary material.

Abstract

A new Abstract in compliance with M.P.E.P. §608.01(b) is being submitted to replace the Abstract objected to in the Office Action. Therefore, the objection should be withdrawn.

Minor Informalities/Objections and rejections under 35 U.S.C. §112, second paragraph.

Claims 1-6 and 9-25 have been amended to address the "Minor Informalities" and the rejections under 35 U.S.S. §112. Therefore, the objections and the rejections of the Office Action should be withdrawn.

Traversal of the rejection of claims 1-6, 8-10, and 23-25 under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent No. 3,551,204 ("BOLGER").

As the Examiner is well aware, in order to anticipate a claim, the cited prior document must disclose each and every recitation of the claim. Amended claims 1 and 23 recite, *inter alia*, that the epoxy resin-cured product contains a halogen atom. This is not disclosed in BOLGER. Therefore, BOLGER fails to anticipate the rejected claims and the rejection should be withdrawn.

Traversal of the rejection of claims 11-16 and 18-22 rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over BOLGER.

Applicants respectfully submit that the disclosure in BOLGER of removing "residual solvent composition from said devices or wiring" does not encompass a process step of separating the inorganic matter from the liquid obtained in the treating step. Therefore, BOLGER fails to anticipate the rejected claims.

In addition, with regard to the alternative rejection under 35 U.S.C. §103(a), it is well settled that in order for a *prima facie* case of obviousness to be established, the prior document must provide some suggestion or motivation to modify its invention to arrive at the claimed invention. BOLGER provides no suggestion or motivation to modify its process to include such a separating step. Therefore, a *prima facie* case of obviousness has not been properly established and the rejection should be withdrawn.

Traversal of the rejection of claims 7 and 17 under 35 U.S.C. §103(a) as being obvious over BOLGER in view of any of Japanese Unexamined Patent Application Publication Nos: 8-325436, 8-325437, 8-325438, 9-316445, or 10-126052.

The presently claimed invention is directed to an epoxy resin-cured product containing a halogen atom. Because of this, the product is easily decomposed, thereby obtaining a compound recyclable as a raw material of synthetic resins. In other words, the present invention enables recycling of the epoxy resin-cured product and composite material without crushing or pulverization thereof which could otherwise limit the recycling process of collected material. In contrast, the cited documents relate to an etching solution. The purpose of the etching is to remove unwanted parts of the cured epoxy resin during wiring applications. Therefore, the cited documents are in no way relevant to the recycling application of the present invention and there is no motivation or suggestion to combine BOLGER with the other cited Japanese documents. For this reason alone, the rejection should be withdrawn.

Applicants also note that since claim 7 is cancelled, the rejection to claim 7 is moot.

Traversal of the rejection of claims 23-25 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,536,439 ("HARBIN").

Amended claims 23-25 recite, *inter alia*, that the epoxy resin-cured product contains a halogen atom. This is not disclosed in HARBIN.

Therefore, HARBIN fails to anticipate the rejected claims and, for this reason alone, the rejection should be withdrawn.

Traversal of the rejection of claims 23-25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,780,894 ("SHIBATA").

Amended claims 23-25 recite, *inter alia*, that the epoxy resin-cured product contains a halogen atom. This is not disclosed in SHIBATA and SHIBATA contains no suggestion or motivation for one of ordinary skill in the art to modify its invention to arrive at the claimed halogen atom. For this reason alone, the rejection should be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to telephone the undersigned at the telephone number below.

Respectfully Submitted,
Katsuji SHIBATA et al.



Bruce H. Bernstein
Reg. No. 29,027

December 17, 2004
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Stephen M. Roylance
Reg. No. 31,296